



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,759	08/16/2005	Gary Mark Coppola	4-32859A	1610
75074	7590	02/04/2009		
NOVARTIS INSTITUTES FOR BIOMEDICAL RESEARCH, INC. 400 TECHNOLOGY SQUARE CAMBRIDGE, MA 02139				
EXAMINER				
MABRY, JOHN				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
02/04/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Addendum to Advisory Action

Applicant's response on January 21, 2009 filed in response to the Final Office Action dated November 4, 2008 has been received and duly noted.

In view of this response, the status of the rejections/objections of record is as follows:

Status of the Claims

Claims 7-9, 12, 13, 18-20, 22 and 33 are rejected.

Claims 1-6, 10, 11, 14-17, 21, 23, 24 and 34-39 have been cancelled.

Claims 25-32 are drawn to non-elected subject matter.

35 USC § 112 Rejection(s)

The 112-1st rejection of claims 7-9, 12, 13, 18-20, 22 and 33 regarding the scope of enablement under 35 U.S.C. 112, first paragraph, regarding the scope of enablement of R1-R2 and R6-R9 is acknowledged but not persuasive. The rejection is duplicated below:

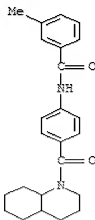
Art Unit: 1625

As described in previous Non-Final Office Action and Final Office Action, R1-R2 and R6-R9 is not enabled to be the entire scope as claimed (more specifically the terms optionally substituted, heterocyclic, aryl and heteroaryl groups). Additionally, Examiner notified Applicant that instant claims were only enabled where R13 and R14 being only H – not the full scope as claimed.

35 USC § 102 Rejection(s)

Applicant's arguments with respect to 102 rejections have been fully considered and are not persuasive. Claims 1, 2, 3, 7, 8, 9, 11 and 33 rejections are maintained under 35 U.S.C. 102(b) as being anticipated by Ogawa et al (WO 9401113 A1).

Ogawa et al clearly discloses compounds and pharmaceutical compositions of Formulas I and Ia wherein R13 and R14=H, W=NR5C(O)R6 wherein R5=H and R6=methylphenyl and R1 and R2=H (see compound 2-149, page 146).



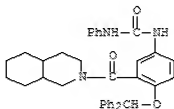
35 USC § 103(a) Rejection(s)

Applicant's arguments with respect to 103(a) rejections have been fully considered and are not persuasive. The 103(a) rejection of claims 18, 19, 20 and 33 regarding obviousness over Matsumoto et al (WO 2003029199 - US equivalent 2004/0259912 A1) is acknowledged but not persuasive.

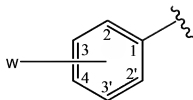
Claims 18, 19, 20 and 33 rejections are withdrawn under 35 U.S.C. 103(a) as being obvious over Matsumoto et al (WO 2003029199 - US equivalent 2004/0259912 A1).

The instant application claims compounds and pharmaceutical compositions of Formulas I and Ih wherein $R^1=H$, $W=NR^5Z$ wherein $R^5=H$ and $Z=C(O)NHPh$ and $R^2=Ph_2CHO-$ (a substituted alkoxy).

Matsumoto discloses compounds and pharmaceutical compositions of Formulas I and Ih wherein $R^1=H$, $W=NR^5Z$ wherein $R^5=H$ and $Z=C(O)NHPh$ and $R^2=Ph_2CHO-$ (a substituted alkoxy) (see Example 396, Table 1, page 117 and paragraph 1682, page 65).



Matsumoto differs from the instant application at the position of W: Applicant's -NR⁵Z at the 3'-position versus Applicant's 4-position. These are positional isomers.



Conclusion

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Mabry, PhD whose telephone number is (571) 270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's primary examiner can be reached at (571) 272-0684, first, or the Examiner's supervisor, Janet Andres, PhD, can be reached at (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1625

/John Mabry/
Examiner,
Art Unit 1625

/Rita J. Desai/

Primary Examiner, Art Unit 1625